

REMARKS

Claims 1-40 remain in the application. Claims 22-40 are withdrawn from consideration. Applicant respectfully requests re-examination.

Claims 1-21 were rejected under 35 U.S.C. § 112 as being indefinite on the grounds that the claim recites two base layers. Claim 1 has been amended to recite one base layer and one wear layer. Applicant believes claims 1-21 are now definite.

Claim 2 was rejected under 35 U.S.C. § 112 as indefinite because it was unclear as to which base layer was to be butadiene rubber. Applicant believes the amendment to claim 1 which now recites one base layer and one wear layer renders claim 2 definite.

Claims 15, 19 and 21 were rejected under 35 U.S.C. § 112 as being indefinite on the grounds that “the wear layer” in the claim has insufficient antecedent basis. Applicant submits that the amendment to claim 1 has obviated this rejection. Applicant respectfully requests that the rejections under 35 U.S.C. § 112 be withdrawn.

Claim 1, was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Byrne* (5,396,731) in view of *Tsao et al* (5,678,353). Applicant respectfully traverses.

Claim 1 recites the elements of a structure for a tree well skirt or a sidewalk. The structure is composed of two distinct different material layers, a base layer and wear layer. The base layer is composed of rubber and a first binder and the wear layer is composed of EPDM and a second binder. The layers act synergistically to reduce the probability of root heave damage by allowing the transmission of water and nutrients through the structure and flexing to

accommodate root growth. The structure is durable and can be used as a sidewalk or tree well skirt (application, paragraph 33).

The office action asserts that *Byrne* discloses a structure for use as a tree skirt or sidewalk comprising a base layer at 15 or 16 (office action page 3, lines 17 and 18). The elements cited refer to the upper surface 15 and the lower surface 16 of a pad 10, *Byrne* (col 3, lines 56-60, fig 2 & 3). *Byrne*'s pad is monolithic and does not have the two materially different layers of claim 1. The office action also asserts that although *Byrne* does not disclose a base layer of EPDM, *Tsao* does (office action page 4 lines 2-4). The *Tsao* patent does not recite a layer of EPDM. Moreover, *Tsao* fails to mention a wear layer composed of EPDM and a binder.

Applicant respectfully submits that because of these differences claim 1 is patentably distinct over any combination of *Byrne* and *Tsao*. Accordingly, Applicant requests that this rejection be withdrawn.

Claims 2-3, 6-11, 12/10, 12/11, 13-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Byrne* as modified by *Tsao* and further in view of *Farley* (5,730,773). Applicant respectfully traverses.

Claims 2-3, 6-11 12/10, 12/11, 13-14 depend from and further limit claim 1. *Farley* does not remedy the gaps in any combination of *Byrne* and *Tsao*. Applicant submits that the claims are therefore patentable for the same reasons as set forth above for claim 1.

Claim 2 also recites a base layer of butadiene rubber. The office action acknowledges that neither *Byrne* nor *Tsao* disclose a base layer of butadiene rubber and asserts that *Farley* does (office action, page 4 lines 10-11). However, *Farley* teaches away from the use of butadiene rubber where he states that natural rubber is his preferred embodiment.

Claims 10 and 11 recite ratios of binder to granules for different embodiments. The office action asserts that it would have been obvious to anyone of ordinary skill in the art to combine *Byrne*, *Tsao* and *Farley* and to experiment with such a combination to produce a structure with a natural appearance (office action, lines 10-15).

The ratios recited in the claim are not to produce a structure with a natural appearance as asserted. They are preferred ratios for tree skirts and sidewalks (application, paragraph 38). Since the base layer is below the wear layer, a natural appearance is not an important design consideration. The ratios are based on many other design criteria and are the result of many engineering tradeoffs (application paragraph 37-46). Applicant submits that if a person skilled in the art were able to combine *Byrne*, *Tsao* and *Farley*, the resulting product would not be the claimed invention. Moreover, the binder to granules ratios could not be found through routine experimentation.

Claims 13-14 recite thicknesses for the base layer. The office action asserts that after combining *Byrne*, *Tsao* and *Farley*, it would have been obvious for someone skilled in the art to determine a size large enough for outdoor use (office action, page 5 line 18 – page 6 line 2).

The thickness recited is not just based on suitability for outdoor use. The disclosure recommends different thicknesses for sidewalks, patios, and tree well skirts (application, paragraph 38). Much like the granule to binder ratio, preferred thicknesses are based on a variety of factors and cannot be found through routine experimentation.

Applicant requests that this rejection be withdrawn.

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Byrne* as modified by *Tsao* and *Farley* and further in view of *Stella* (4,882,386).

Claims 4-5 depend and further limit claim 2. *Stella* does not remedy the gaps in any combination of *Byrne*, *Tsao*, and *Farley* and is patentable for the same reasons as stated above for claim 2.

Claim 4 recites the binder is isocyanate polyurethane. The office action asserts that someone of ordinary skill in the art would be able to combine *Byrne*, *Tsao*, and *Farley* and use the isocyanate polyurethane of *Stella* as the binder in the combination (office action page 6 lines 6-11).

Stella does not disclose the use of isocyanate polyurethane as a binder. Not only would the combination of these four references not produce the claimed invention, but a person of ordinary skill would not be taught to use isocyanate polyurethane as the binder.

Claim 5 recites the isocyanate polyurethane is 16% by weight. The office action asserts that someone of ordinary skill in the art would be able to combine *Byrne*, *Tsao*, and *Farley* and *Stella* and experiment to come to a ratio of 16% by weight for the binder (office action page 6 lines 12-16).

The 16% binder to rubber ratio is a result of many engineering tradeoffs that include factors such as cure time (application paragraph 41-42). Applicant submits that the ratio cannot be found by routine experimentation.

Applicant respectfully requests that this rejection be withdrawn.

Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Byrne* as modified by *Tsao* and further in view of *Stella*.

Claims 15-18 depend from and further limit claim 1. *Stella* does not remedy the gaps in any combination of *Byrne* and *Tsao*. Claim 15-18 are patentable for the same reasons as stated above for claim 1.

Claims 15 and 16 define binder of the wear layer as isocyanate polyurethane with a 20% by weight ratio. Applicant submits that none of the references by themselves, or in combination teach the claimed invention.

Applicant respectfully requests that this rejection be withdrawn.

Claims 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Byrne* as modified by *Tsao* and further in view of *Schuurink* (4,205,102).

Claims 19-21 depend from and further limit claim 1. *Schuurink* does not remedy the gaps in the combination of *Byrne Tsao*. Applicant submits that claims 19-21 are patentable for the same reasons as set forth above for claim 1.

Claim 21 recites a base layer two to three inches thick and a wear layer three eighths to one half inch thick. The office action claims that after combining three references it would have been obvious for someone of ordinary skill in the art through experimentation to arrive at the recited dimensions to allow for outdoor use and transport (office action page 6 lines 4-8).

These dimensions are a result of considerable design considerations and engineering tradeoffs (application, paragraphs 29-34). Applicant submits that the dimension would not be obvious through routine experimentation.

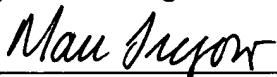
Applicant respectfully requests that the rejection be withdrawn.

In light of the above amendment and remarks, Applicant respectfully submits that claims 1-21 are allowable and requests that all the claims be allowed and the application passed to issue.

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